

AUS920010583US1

## REMARKS

Double Patenting

Claims 1 - 33 in the present application are rejected for obviousness-type double patenting over claims 1-12 of copending Application No. 09/881915, over claims 1-22 of copending Application No. 09/882174, over claims 10-15 of copending Application No. 09/881919, and over claims 1-20 of copending Application No. 09/881917. The Office Action states that claims 1-33 are rejected as being unpatentable over claims 1-12 of copending Application No. 09/881915 because:

... they are not patentably distinct from each other because the limitations of the independent claims 1, 12, 23 are similar to claim 1 of copending Application No. 09/881915. The limitations 'assigning director authority in a system that streams digital content from a multiplicity of sources of digital information to a multiplicity of client devices under control of a multiplicity of directors' is equivalent to the use of remote direction of streaming digital content from a multiplicity of sources of digital information to a multiplicity of client devices upon a network of digital computers comprising a content server receiving digital content from the sources and the digital content having a multiplicity of digital formats.

The law governing double patenting is that the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) are applied for establishing a background for determining obviousness under 35 U.S.C. 103 and are employed when making an obviousness-type double patenting rejection. The *Graham* factual inquiries require the Examiner to:

- determine the scope and content of the art as described in copending application no. No. 09/881915;

AUS920010583US1

- determine the differences between the scope and content of the art as described in copending application no. No. 09/881915 and the claims at issue;
- determine the level of ordinary skill in the pertinent art; and
- evaluate any objective indicia of nonobviousness.

The Office Action Fails to Establish the Required  
Background for the Double Patenting Rejection

As described above, the Office Action must apply the Graham factors to establish the required background for a double patenting rejection. The Office Action fails to apply a single Graham factor to establish any of the necessary background elements for determining obviousness. In fact, the Office Action does not even mention the *Graham* factors. In the complete absence of any mention or consideration of the Graham factors whatsoever, applicants can offer no further analysis on this issue. The Office Action clearly cannot support an obviousness-type double patenting rejection, and the rejection should be withdrawn.

The Office Action Fails to State Reasons Why a Person of Skill  
in the Art Would Conclude that the Claims are Obvious

The Office Action presents no argument why a person of ordinary skill in the art would conclude that claims 1-33 in the present case are obvious in view of claims 1-12 of copending Application No. 09/881915. Treating the disclosures of application no. 09/881915 as a description of the relevant art, the office action's only pronouncement regarding the art is that the present claims are 'similar to' the claims of application no. 09/881915:

AUS920010583US1

Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation of independent claims 1, 12, 23 are similar to claim 1 of copending application no. 09/881915.

And:

The limitation of dependent claims 1-11, 13-22, 24-33, are similar to claims 2-12 of copending application no. 09/881915.

Clearly the assertion that the claims are 'similar' conveys nothing regarding why a person of skill in the art would conclude that claims 1-33 in the present case are obvious in view of claims 1-12 of copending Application No. 09/881915.

#### Summary Regarding Double Patenting

The double patenting rejections of the claims of the present application over claims 10-15 of copending Application No. 09/881919, over claims 1-20 of copending Application No. 09/881917, and over claims 1-22 of copending Application No. 09/882174 should be withdrawn for the same reasons as set forth above for the rejections over claims 1-12 of copending Application No. 09/881915. In summary regarding the double patenting rejections, therefore: The Office Action of September 24, 2004, does not establish the necessary background for determining obviousness required by an obviousness-type double patenting rejection. Furthermore, the Office Action fails to articulate reasons why a person of ordinary skill in the art would conclude that claims 1-33 in the present case are obvious in view of claims 1-12 of copending Application No. 09/881915, claims 10-15 of copending Application No. 09/881919, and claims 1-20 of copending Application No. 09/881917. The rejection of claims 1-33 should therefore be withdrawn.

#### Title Of The Application

There is no need to amend the title of the present application. The Office Action states:

AUS920010583US1

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The office action suggests the title, "Director authorized to control and transcode servlets of content server to stream digital content over network."

Applicants in response respectfully note that 37 C.F.R. § 1.72(a) requires titles to be "as short and specific as possible." The application is presently titled, "Assignable Director Authority For Control of Streaming Digital Content." Applicants propose that the title is short, specific, descriptive, and in complete compliance with 37 CFR § 1.72(a).

Applicants therefore respectfully decline to amend the title.

#### Brief Summary of the Invention

There is no need to amend the Brief Summary of Invention. The Office Action states:

The BRIEF SUMMARY OF THE INVENTION section should contain brief description of the disclosed subject matter rather repetitive claimed language of the claims

Applicants respectfully note that 37 C.F.R. §1.73 requires, "Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed." Applicants use claim terminology to assure compliance with 37 C.F.R. § 1.73. Applicants respectfully propose that claim terminology is the very best terminology for compliance with 37 C.F.R. 1.73 because claim terminology is assured to be "commensurate with the invention as claimed." For these reasons, applicants respectfully decline to amend the Brief Summary of Invention.

#### Requirement of Information

AUS920010583US1

There is no need to provide additional information. The Office Action states:

Unless the invention is created from scratch, applicants needs to provide all the prior arts that have led to the invention, i.e., existing patents and publications related to the claimed subject matter. In response, applicants is requested to provide the title, citation and copy of each publication related to the claimed subject matter. For each publication, please provide a concise explanation of that publication's contribution to the description of the prior art. Appropriate correction is required.

37 CFR 1.105(a)(3) provides, "Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply." Applicants respectfully submit, in accordance with 37 CFR 1.105(a)(3), that the information required is unknown and is not readily available to the applicants.

#### Drawings

The Office Action requests the submission of formal drawings. Formal drawings were submitted on January 29, 2004, and are currently available on PAIR. In an effort to move the case forward and for Examiner Patel's examining convenience, Applicants submit with this Response a copy the formal drawings as filed on January 29, 2004. The objection to the drawings should be withdrawn.

AUS920010583US1

Rejections – 35 U.S.C. § 112The Office Action Fails To State A Prima Facie Case Of  
Inadequate Written Description Under 35 USC 112.

The Office action fails to state a prima facie case of inadequate written description under 35 USC 112. The Office Action states, "Claims 1, 12, 23 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement." The Office Action alleges three particular failures of the written description requirement from claims 1, 12, and 23:

"system that streams digital content from sources of digital information",

"director having director attributes", and

"director instructions of a store".

The legal requirements for a prima facie case of inadequate written description are set forth in MPEP 2163 I A which states, "There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ... " The court in *Wertheim* said, among other things, " ... the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims."

In addition, MPEP 2163 III A states "A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See.e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). MPEP also states "...the examiner must set forth express findings of fact ... [and] (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized

AUS920010583US1

that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection of lack of adequate written description."

Further regarding this rejection, the Office Action states:

As per line 23, col., 12 of the specification, "digital content" can be just "text," "director attributes" can be "hardware items," and "director instructions" can be "manual instructions or database data processing means or steps for organizing or inter-relating data or files (e.g., rational, network, hierarchical, and entity-relationship models), or data processing means or steps for generic data, file and directory upkeep, file naming, and file and database maintenance including integrity consideration, recovery, and versioning. [emphasis added]

Applicants propose that, just as a general allegation of 'unpredictable in the art' is not a sufficient reason to support a rejection of lack of adequate written description, so also it a general allegation that a claim element 'can be' some processing means or step cannot be a sufficient reason to support a rejection of lack of adequate written description. A prima facie case charged with overcoming a strong presumption of adequate written description cannot be made by such thin allegations.

No Rejection For Inadequate Written Description is  
Possible In This Case Because The Case Contains  
Written Description Fully Compliant With 35 USC 112

As shown above, no prima facie case for inadequate written description is presented in the Office Action. Applicants are therefore required to make no further showing regarding the adequacy of written description, and the rejection should be withdrawn. Nevertheless, in an effort to move the case forward, applicants will briefly show, in addition to the fact that no prima facie case is presented, also that no rejection for

AUS920010583US1

inadequate written description is possible because the application contains adequate written description.

More particularly, written description for "digital content," streamed, streaming, or in a stream, is found in the specification at:

- page 11, lines 22, 23
- page 12, lines 4, 6, 13, 20, 21, 24
- page 13, lines 3, 4, 5, 8, 21, 26
- page 14, line 12
- page 54, lines 15, 26
- page 17, line 19
- page 18, line 25
- page 19, lines 3, 12, 23
- page 20, lines 3, 23
- page 23, lines 14, 19, 27
- page 19, line 19
- page 26, lines 2, 9, 16
- page 28, line 5
- page 19, line 19
- page 31, line 1

In addition, written description of "director attributes" is found in the specification at:

- page 24, lines 5, 18, 20, 24
- page 25, lines 2, 10, 11
- Figure 6, references 514, 528, 530
- Figure 7, references 514, 528, 530



AUS920010583US1

In addition, written description of "director instructions," remote, stored, and otherwise, is found in the specification at:

- page 13, lines 2, 3
- page 14, lines 3, 4, 7, 11
- page 16, lines 4, 14, 22
- page 17, line 9
- page 19, line 20
- page 22, line 17
- page 23, lines 14, 17, 19
- page 24, lines 6, 7, 10, 11, 12, 23, 25
- page 25, lines 3, 4, 6, 7, 10, 11, 12, 13, 14, 17, 18, 19, 20, 24
- page 26, line 19
- page 27, line 16
- page 28, lines 17, 26
- page 29, lines 4, 5, 6, 8, 9, 18, 19, 20, 24
- page 30, lines 21, 23
- Figure 2, reference 204
- Figure 5, reference 516
- Figure 6, reference 516
- Figure 7, reference 516

In view of these written descriptions, there is clearly adequate written description in the specification to meet the requirements of 35 USC 112, and the rejection for inadequate written descriptions should be withdrawn.

Claim Rejections – 35 U.S.C. §102

Claims 1-33 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bridgman *et al.* (US 2002/0087655 A1). As will be shown below, Bridgman, does not anticipate a method, system, and product for streaming digital content from a multiplicity of sources

AUS920010583US1

of digital information to a multiplicity of directors in conjunction with a network of digital computers as claimed in the present application. Claims 1-33 are therefore patententable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-33.

Claims 1-33 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bridgman *et al.* (US 2002/0087655 A1). To anticipate the claims of the present invention under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Bridgman must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Bridgman must enable Applicants' claims. Bridgman does not meet either requirement and therefore does not anticipate Applicants' claims.

Bridgman Does Not Disclose Each and  
Every Element of Applicants' Claims

Bridgman does not disclose each and every element of Applicants' claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Office Action relies on paragraphs 13 and 14 of Bridgman for anticipation of the preamble of claim 1 of the present application, and the Office Action relies upon paragraphs 58, 59, and 62 of Bridgman for anticipation of the elements of claim 1.

More particularly, paragraphs 13 and 14 and some elements of the Figures are said to anticipate this portion of claim 1:

A method of assigning director authority in a system that streams digital content from a multiplicity of sources of digital information to a multiplicity of client devices under control of a multiplicity of directors, the method implemented in conjunction with a network of digital computers, at least one of the digital

AUS920010583US1

computers comprising a content server upon which the steps of the method are implemented in computer memory and upon at least one computer processor, each director having director attributes, the content server including a store of director instruction records wherein each director instruction record represents one director instruction ...

And paragraphs 58, 59, and 62 are said are said to anticipate this portion of claim 1:

extracting for a director, in dependence upon the director's attributes, director instructions from the store of director instruction records; and  
downloading the extracted director instructions to the director.

Paragraphs 13 and 14 represent the SUMMARY OF THE INVENTION in Bridgman.  
Paragraph 13 summarizes the invention of Bridgman as:

... a voice interface using voice recognition input and speech synthesis output that allows the driver to access information by conversing with the auto client device while continuing to operate the vehicle without recourse to normally used computer interface means ...

Paragraph 14 further summarizes as the invention of Bridgman as one in which, "... speech is transformed into digital text data at the client side and transmitted over a data link." Clearly neither paragraph 13 nor 14 of Bridgman has anything whatsoever to do with "... assigning director authority in a system that streams digital content from a multiplicity of sources of digital information to a multiplicity of client devices under control of a multiplicity of directors ..." and so on as claimed in the preamble of claim 1 of the present application.

Paragraph 58 of Bridgman describes a method of generating a speech markup language document from an HTML document. Paragraph 58 of Bridgman describes the general operation of Java servlets<sup>TM</sup> as "... an applet running on the server instead of the client."

AUS920010583US1

Paragraph 58 of Bridgman describes the general operation of a Wireless Domino Access® server as a suite of programs which enable access to data residing in selected Lotus Domino® databases ...” Clearly neither paragraph 58 nor 59 nor 62 discloses anything having anything whatsoever to do with the elements of claim 1 in the present application, extracting and downloading director instructions to a director.

Because Bridgman discloses nothing having anything to do with the claim 1 of the present application, Bridgman does not teach each and every element of Applicants’ claims 1. Independent claims 12 and 23 recite system and computer program product claims corresponding to the method claimed in independent claim 1. Rejected claims 2-11, 13-22, and 24-33 depend from independent claims 1, 12, and 23 and include all of the limitations of those independent claims. If Bridgman does not anticipate the elements of claim 1, and it does not, then all of the claims of the present application are patentable. All rejections of all claims in the present application should be withdrawn.

Bridgman Is Not An Enabling  
Disclosure of Applicants’ Claims

There are two required aspects of anticipation. Not only must Bridgman disclose each and every element of the claims of the present invention within the meaning of *Verdegaal* in order to anticipate the claims, but also Bridgman must be an enabling disclosure of the claims of the present invention within the meaning of *In re Hoeksema*. The Appellants’ claims in *Hoeksema* were rejected because an earlier patent disclosed a close structural similarity to appellant’s chemical compound. The court in *Hoeksema* stated: “We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The *Hoeksema* court contrasted the so-called ‘Von Bramer doctrine’ with the requirement for a reference to be enabling:

AUS920010583US1

In *In re Brown*, 51 CCPA 1254, 329 F.2d 1006, 141 USPQ 245 (1964), this court discussed *In re Von Bramer*, 29 CCPA 1018, 127 F.2d 149, 53 USPQ 345 (1942), commenting that that opinion should not be construed to encompass what had come to be called the "Von Bramer doctrine." There we stated, 51 CCPA at 1257, 329 F.2d at 1009, 141 USPQ at 247:

This doctrine which appears to have resulted from *In re Von Bramer et al.*, *supra*, seems over a period of years to have been tailored in some quarters to a principle which defeats the novelty of a chemical compound on the basis of a mere printed conception or a mere printed contemplation of a chemical "compound" irrespective of the fact that the so-called "compound" described in the reference is not in existence or that there is no process shown in the reference for preparing the compound, or that there is no process known to a person having ordinary skill in the relevant art for preparing the compound. In other words, a mere formula or a mere sequence of letters which constitute the designation of a "compound," is considered adequate to show that a compound in an application before the Patent Office, which compound is designated by the same formula or the same sequence of letters, is old. We do not think that the Von Bramer case should be so construed.

To the extent that anyone may draw an inference from the Von Bramer case that the mere printed conception or the mere printed contemplation which constitutes the designation of a "compound" is sufficient to show that such a compound is old, regardless of whether the compound is involved in a 35 USC 102 or 35 USC 103 rejection, we totally disagree.

The meaning of *Hoeksema* for the present case is that it is insufficient as anticipation under 35 USC 102(e) for Bridgman to express a "mere printed conception" or "mere printed contemplation" of some of the elements of the claims of the present application. The test for sufficiency of enabling disclosure is whether it places an invention in the

AUS920010583US1

possession of a person of ordinary skill in the art.

Paragraphs 13 and 14 of Bridgman are expressly summary material, making no pretense to be an enabling disclosure of anything. Paragraphs 58, 59, and 62 of Bridgman, being as they are respectively a description of speech markup language document development, Java servlets, and Wireless Domino Access servers, cannot possibly convey an enabling description of assigning director authority as claimed in the present application. In fact, none of the terms "digital content," "director authority," "digital information," "director instruction," "director's attributes," and "director instruction records" even occurs in Bridgman. Rejections under 35 USC 102 based on Bridgman should be withdrawn, and independent claims 1, 12, and 23, as well as their rejected dependent claims 2-11, 13-22, and 24-32 should be allowed.

#### Conclusion

To serve as a basis of rejection under 35 USC 102, Bridgman must disclose and enable each and every element of claim 1 of the present application. Because Bridgman does not disclose or enable any of the elements of claim 1 in the present application, none of the claims of the present application can be rejected in reliance on Bridgman. The rejection of claims 1-33 should be withdrawn and the case should be allowed.

AUS920010583US1

The Commissioner is hereby authorized to charge or credit Deposit Account No. 503082 for any fees required or overpaid.

Respectfully submitted,

Date: 12/16/2004

By:



John Biggers

Reg. No. 44,537

Biggers & Ohanian, LLP

504 Lavaca Street, Suite 970

Austin, Texas 78701

Tel. (512) 472-9881

Fax (512) 472-9887

ATTORNEY FOR APPLICANTS